

May 11, 2008

Robert J. Gunther, Jr.

By Email and Fax

Honorable Ron Clark
United States District Court
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RE: *Anascape v. MS & Nintendo* (Case No. 9:06-CV-00158-RC)

Dear Judge Clark:

On two occasions during trial, the Court instructed the jury on the priority/written description issue. The first instruction was given after my opening statement; the second was given during my cross-examination of Mr. Armstrong. There had been no prior objection by Anascape in either case. At the time these instructions were given, I was puzzled, because it seemed like the Court was simply giving the jury an instruction that was the essentially the same as the legal standard as I articulated it, albeit using different words. During trial on Thursday, the Court indicated that it had given these instructions because the Court believed that I had inadvertently misstated the law on this point. Given the importance of this issue, I went back to look at what I said on both occasions and have also looked again at the law. In neither case did I misstate the appropriate legal standard.

During my opening, I made the following statement:

And as a matter of fact, to do that, to write those claims later and then say that they are part of the 1996 invention, a continuation patent requires something very specific. You can't change the invention. That means what's described in 1996 has to be the same as what was filed in—as the claims that were filed in 2002. They must be the same. And, ladies and gentlemen, what that means is those claims will live or die based on whether they are the same invention as what he described in 1996.

Trial Tr. at 123:3-13.

During the cross-examination of Mr. Armstrong, just before the Court's instruction, I was examining Mr. Armstrong on the changes in his November 2000 application for the '700 patent as compared to his 1996 application. In a question, I asked Mr. Armstrong whether "the invention has to be the same at both points in time," i.e., 1996 and 2000, and, without objection, he answered "yes." Trial Tr. at 307: 14-18. A few pages later, I referred to a part of the 1996 application "that talks about your [Mr. Armstrong's] invention." Trial Tr. at 309:14-22. Again, there was no objection, and Mr. Armstrong answered the question affirmatively.

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The law makes clear that my framing of the priority/written description standard was correct. *In Lizardtech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336 (Fed. Cir. 2005) the Federal Circuit articulated the written description requirement as follows: the specification “must describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the application, i.e., *that the patentee invented what is claimed*. *Id.* at 1345 (emphasis added). See also *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1255 (Fed. Cir. 2004) (“The written description requirement prevents applicants from using the amendment process to update their disclosures (claims or specifications) during their pendency before the patent office. Otherwise applicants could add new matter to their disclosures and date them back to their original filing date, thus defeating an accurate accounting of the priority of invention.”); *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1346 (Fed. Cir. 2000) (“the written description requirement requires that the specifications of these patents describe the inventions claimed in these patents”); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991) (“Adequate description of the invention guards against the inventor’s overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.”); *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”).

The law as derived from these cases makes clear that the later written claims must contain the same invention as that which was described in the original patent application. If the later claims describe a different invention which is not described in the earlier application, they are not entitled to the filing date of the original application. This is exactly how I framed the standard both in my opening and in the cross-examination of Mr. Armstrong. And that is why highly skilled counsel on the other side never objected—because I was correctly stating the law, albeit in words slightly different from the Court’s instructions.¹

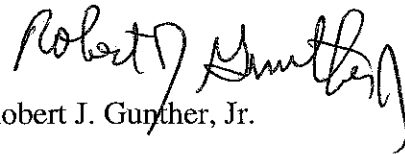
Finally, the Court appeared to be concerned that I was referencing the fact that the 1996 and 2000 applications discuss the invention. At one point, the Court stated that “the specification is not the invention.” Trial Tr. at 923:7-9. With respect, I’m not certain what the Court meant by this statement. The fact of the matter is that the specifications contained in the 1996 and 2000 applications contain a description of the invention. 35 U.S.C. § 112, entitled “Specification” states, “The specification shall contain a written description of **the invention**. . . .” 35 U.S.C. § 112, ¶ 1 (emphasis added). The claims then define that invention in terms of the patent owner’s right to exclude. This is elementary patent law as confirmed by the patent law

¹ Of course, I am painfully aware that I am by no means perfect (I have six children who make this clear to me on a regular basis) and am certainly capable of making an inadvertent or unintentional misstatement. If, during the remaining course of the trial the Court believes me to have made a misstatement, particularly if opposing counsel has not objected, I respectfully request that the Court discuss it with me and opposing counsel before instructing the jury, since the very act of giving the instruction could convey to the jury the impression that I had done something wrong. If I or anyone else makes a misstatement, a jury instruction may be appropriate. But where, as here, no misstatement has been made, then the timing of such an instruction, even though it correctly states the law, could be prejudicial.

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video that this Court shows the jury at the beginning of every patent trial (stating that the inventor must “describe and claim” the invention in compliance with law and regulation, and “the application is a typewritten document in which the inventor describes the invention he or she is trying to protect.”). The portion of my opening statement quoted above and my questioning of Mr. Armstrong were consistent with the foregoing.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert J. Gunther, Jr.", written in a cursive style.

Robert J. Gunther, Jr.

cc: All counsel of record (by email)